UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,624	01/11/2001	Douglas R. Elliott	TEQ 1117005	8961

32233 7590 01/30/2006

STORM L.L.P.
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

EXAMINER	
DASS, HARISH T	
ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/758,624	ELLIOTT, DOUGLAS R.	
	Examiner	Art Unit	
	Harish T. Dass	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-43* is/are pending in the application.

4a) Of the above claim(s) *1-11 and 18-43* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-11, and 18-43 are withdrawn.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Because, claims are directed to the method, and however, the body of the claims do not recite any step, thus it is not clear whether applicant invention is directed to method claim or product claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risen, Jr. et al (hereinafter Risen - US 6,018,714) in view of Champion et al (hereinafter Champion – US 5,126,936), Kieso et al "Intermediate Accounting", John Wiley & Sons, Inc., eighth edition 1995, pages 571-619; ISBN 0-471-59759-7 (hereinafter Kieso) and

FindLaw for Legal Professionals "US Fed Circuit Court of Appeals – Rhone-Poulence v Dekalb Genetics", decided March 26, 2002 (hereinafter FindLaw).

Re. Claim 12, Risen discloses, data processing system, intellectual property, and more particularly relates to protection against changes in value of intellectual property [see entire document particularly, Abstract; Fig. 1; C1 L1 to C4 L63], a) identifying an intellectual property [C27 L25-L30],

b) identifying initial ownership of said intellectual property [C27 L25-L30],

i) identifying at least one other intellectual property [C9 L30-35; C27 L25-L30],

j) identifying initial ownership of said at least one other intellectual property [C27 L25-L30] and,

k). assessing (determining) a value for said at least one intellectual property [Abstract; C8 L64 to C9 L56].

Risen does not explicitly disclose a computer code, using a method or c) an algorithm for assessing a value of an intellectual property.

d/l) obtaining title to said intellectual property <dl> in exchange, paying the initial ownership, from a general trust account, an amount not more than the accessed value of said intellectual property, <d2> obtaining funding for said general trust account from a plurality of initial investor accounts,

e) creating said investor accounts by identifying a plurality of investors, obtaining an initial amount from each of said investors and associating in at least one electronic

database at least a portion of said initial amount with at least one investor account for each said investor,

g) allocating said at least one payment from said initial ownership to said general trust account in at least one electronic database,

h) allocating payments from said general trust account to at least one of said investor accounts in at least one electronic database,

I) obtaining title to said at least one other intellectual property in exchange for paying not more than the assessed value of said at least one other intellectual property to said initial ownership, <I1> obtaining said payment to the initial ownership from a general trust account, <I2> obtaining funding for said general trust account from at least one subsequent investor account,

m) creating said subsequent investor accounts in at least one electronic database by identifying a plurality of investors, obtaining an initial amount from each of said subsequent investors and associating at least a portion of said initial amount with said investor account in at least one electronic database for each said subsequent investor,

n) granting a license to said initial ownership to use said in at least one other intellectual property in exchange for at least one payment from said initial ownership,

o) allocating said at least one payment for said license for said at least one other intellectual property from said initial ownership to said general trust account in at least one electronic database, and

p) allocating payments from said general trust account to at least one of said subsequent investor accounts in at least one electronic database.

However, Kieso discloses (c & k) using a method or an algorithm for assessing a value of an intellectual property (precipitator patent, p 599-602, 610-611) using at least one algorithm or Amortization and assessing a value for said at least one other intellectual property [pages 571-619] to evaluate fair market value (purchased price) for intangible asset(s).

Champion, discloses data processing system, computer system (figure 2 # 20), computer code (see programmed control and program language C5 L64 to C6 L5), control account management and investment tracking for participating investors, and database [see entire document particularly – Abstract; Figures 2-3; C1 L1 to C3 L55; C6 L6-L12]. g) allocating said at least one payment from said initial ownership to said general trust account [Champion – C4 L1-L28], and h) allocating payments from said general trust account to at least one of said investor accounts [Champion – C4 L1-L28] to adjust the customer account for customer request of asset allocation, withdrawal or deposit.

Findlaw discloses d/l) obtaining title to said intellectual property, <dl> in exchange, paying the initial ownership and f/n) granting a license to said initial ownership to use said intellectual property in exchange for at least one payment from said initial ownership and granting a license to said initial ownership (a purchaser) to use said in at least one other intellectual property in exchange for at least one payment from said initial ownership (a purchaser) and allocating said at least one payment (paid

value) for said license for said at least one other intellectual property [see al pages 1-16 particularly 3, 5-8, 13 -- initial ownership is not different than a purchaser and he/she can be any one] to not infringe on others property and acquire patent license by fraud.

Further, portfolio of assets are known such as: mutual funds, share of company stocks, or real estate investment trust (REIT) a company that manages a portfolio of real estates to earn profits for shareholders and includes shareholders and investment portfolio (buildings) an accounting system (general account, etc) to manage the investment, access properties (an amount not more than the accessed value of said intellectual property (property), shareholders and shares and more shares which can includes as part of a business structure or business choice an accounting system having: (<d2> obtaining funding for said general trust account from a plurality of initial investor accounts, e) creating said investor accounts by identifying a plurality of investors, obtaining an initial amount from each of said investors and associating in at least one electronic database at least a portion of said initial amount with at least one investor account for each said investor, allocating said at least one payment from said initial ownership to said general trust account in at least one electronic database, allocating payments from said general trust account to at least one of said investor accounts in at least one electronic database, exchange for paying not more than the assessed value of said at least one other intellectual property to said initial ownership, <I1> obtaining said payment to the initial ownership from a general trust account, <I2> obtaining funding for said general trust account from at least one subsequent investor account, creating said subsequent investor accounts in at least one electronic database

by identifying a plurality of investors, obtaining an initial amount from each of said subsequent investors and associating at least a portion of said initial amount with said investor account in at least one electronic database for each said subsequent investor, from said initial ownership to said general trust account in at least one electronic database, and allocating payments from said general trust account to at least one of said subsequent investor accounts in at least one electronic database). For example to clarify the above, buying shares in Intiut or Qualcomm, which owns multiple patents automatically makes the share holder a partial owner who has an account with Intiut (Qualcomm) and Intuit (Qualcomm) uses combine money (fund), which is a pool of funds from investors, to buy a new patent and pay a fair value for it based on Intuit calculation.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to of accounting and finance to modify the disclosure of Risen and include investment portfolio intellectual properties similar to REIT with accounting system where the investment is collected from investors (shareholders) for the purpose of creating a portfolio of properties (intellectual properties) through buying based on an assessing algorithm of Kieso to get a fair value of the property and making payments as described by Champion and obtaining the property title (intellectual property title – conveyance) and licensing to others, as described by Findlaw, to purchase intellectual properties legally and grant license to others for helping the product production and sale which helps the company bottom line.

Re. Claim 13, Risen further discloses granting a limited license to a party other than the original user of said intellectual property and obtaining at least one payment from said licensee of said intellectual property for a license to use said intellectual property [C8 L64].

Re. Claim 14, Risen further discloses allocating payments from said general trust account to at least one account other than an investor account and data processing [C2 L48 to C3 L16; C8 L44 to C9 L43; C26 L12-L33]. Risen does not explicitly disclose in at least one electronic database. However, Champion discloses database to store to handle investor accounts [Abstract; C1 L15-L49; C6 L9-L13]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Risen and include database to handle large amount of accounting information.

Re. Claim 15, Risen, Findlaw or Kieso does not explicitly disclose allocating payments to said investor accounts in the at least one electronic database using at least one algorithm that considers factors in addition to the initial amount obtained from said investor. However, Champion discloses allocating payments and fees [C1 L35-L67; C14 L1-L28] to adjust the customer account for deposit and asset allocations. Further, allocating payments to said investor accounts in the at least one electronic database using at least one algorithm that considers factors in addition to the initial amount obtained from said investor is obvious with is similar to an investor account, to one skill

in the art, in a mutual fund will have a value proportional to the number of shares (units) it has, similarly the dividend, fees, gain or interest it gets will be proportional to it share based on what he/she has in investment. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Risen, Champion, Findlaw and Kieso and include a formula with certain criteria to allocate payments based on the share of the account to satisfy the investors they get their part of business fairly.

Re. Claim 16, Risen, Champion, Findlaw or Kieso explicitly discloses where at least one subsequent investor account and at least one initial investor account are the same. However, it is obvious the account can be same if they have the same ownership, same amount of deposit and at the same financial institution otherwise they are not.

Re. Claim 17, claim 17 is rejected with same rational as claim 12 step d. (It is obvious that different investors have different accounts and even an investor can have different accounts in the same financial institution (i.e. checking/saving accounts, etc.)).

Response to Arguments

2. Applicant's arguments with respect to pending claims, filed 5/27/2005 and 11/7/05, have been fully considered but they are not persuasive.

1- In response to No place in Champion .." and "There is no suggested, explicitly, or implicitly, use of an electronic data processing ...", one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

2- In response to "as a result of the difficulty of evaluation ...", Kieso discloses methods of evaluating the IP. Further, applicant does not claim any particular algorithm which is developed by the applicant.

3. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

4. In response to applicant's argument that Kieso and Champion are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Kieso discloses the accounting methods of IP and

Champion discloses accounting management and finance system which both relate to current application.

5. In response to applicant's argument that Kieso does not disclose electronic data processing, Kieso is a secondary reference, which include limitation.

6. In response to applicant's argument that Rhone does not disclose automated system, Rhone is a secondary (3rd or 4th) reference.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628

1/23/06

HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600